

SUMMARY OF EXAMINER INTERVIEW

Applicants would like to thank the Examiner for granting a telephone interview on Tuesday, June 16, 2009. Applicants discussed proposed amendments to claims 1 and 28, section 101 requirements, and the outstanding rejections. Agreement was reached that, pending approval of the language used in amending the claims to recite computer storage media, claim 1 would be allowable as amended. The Examiner explained that claim 28 required recitation of hardware components in the claim elements, and Applicants agreed to amend claim 28 accordingly.

REMARKS

Applicants respectfully request reconsideration of the present Application. Claim(s) 1-2, 4-8, 10-11, 13-17, 19-26, 28, 34, and 42-44 have been amended herein. Claims 3, 9, 12, 18, 27, and 36 have been cancelled. Care has been exercised to introduce no new matter. Claims 1-2, 4-8, 10-11, 13-17, 19-26, 28-35, and 37-44 are pending and are in condition for allowance.

Rejections based on 35 U.S.C. § 101

The United States Supreme Court has recognized that the expansive language of 35 U.S.C. § 101 includes as statutory subject matter “anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09 (1980). The USPTO has adopted the Supreme Court’s interpretation and has stated that, in practice, the complete definition of the scope of 35 U.S.C. § 101 “is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent.” MPEP 2106(IV)(A).

Claims 1-44 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Specifically, claims 1-44 were rejected for being “directed to a method or a computerized storage system” and “failing to recite any hardware elements in the claim body, which renders the claim solely as a software implementation and non-statutory.” Applicants respectfully traverse these rejections.

Prior to the current amendments, independent claims 1, 10, 19, and 42, and their respective dependent claims, were method claims. Independent claims 1, 10, 19, and 42 have been amended and now claim “[o]ne or more computer storage media having computer-useable instructions embodied thereon for performing a method.” What is claimed is now a “computer storage media,” which is an article of manufacture and not a method. Because independent

claims 1, 10, 19, and 42, and their respective dependent claims, are not methods but articles of manufacture, the claims are not required to be tied to a particular machine or apparatus or transform an article into a different state or thing. *See In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) for “machine or transformation” test. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 101 rejection of claims 1-2, 4-8, 10-11, 13-17, 19-26, and 42-44.

Independent claims 28 and 34, and their respective dependent claims are directed to a “computerized system including one ore more computer storage media.” As stated above, it was noted that these claims failed to “recite any hardware elements in the claim body, which renders the claim solely as a software implementation and non-statutory.” Independent claim 28 has been amended to claim, *inter alia*, “monitoring tools stored on a computer storage media for continuously monitoring a system parameter.” Independent claim 28, and its dependent claims, now recite a hardware element in the claim body. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 101 rejection of claims 28-33.

Similarly, independent claim 34 has been amended and now recites, *inter alia*, “a signature creation module, stored on the one or more computer storage media, for creating a signature representative of the process.” Independent claim 34, and its dependent claims, now recite a hardware element in the claim body. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 101 rejection of claims 34-35 and 37-41.

Rejections based on 35 U.S.C. § 103(a)

A. Applicable Authority

Title 35 U.S.C. § 103(a) declares that a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” In *Graham v. John*

Deere, the Supreme Court counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. See *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP § 2141.02(I) (emphasis in original) (citing *StratoFlex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (C.C.P.A. 1970)). Moreover, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

“The examiner bears the initial burden of factually supporting a *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness To reach a proper determination of obviousness, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. In view of all factual information, the examiner must then determine whether the claimed invention ‘as a whole’ would have been obvious at that time to that person. *Id* (emphasis added). Knowledge of applicant’s disclosure must be put aside in reaching this determination [I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” MPEP § 2142.

“The key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation of the reason(s)** why the claimed invention would have been obvious.” MPEP § 2142 citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007) (emphasis added), which notes that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. Moreover, the Federal Circuit has stated that “rejections on obviousness **cannot be sustained with mere conclusory statements**; instead, there must be some **articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness.” MPEP § 2142 (emphasis added) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). See also *KSR*, 127 S. Ct. at 1741 (quoting Federal Circuit statement with approval).

B. Helsper and McGee and Helsper, McGee, and Spoerre

Claims 1-2, 4-11, 13-18, 28-35 and 37-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Helsper et al., U.S. Publication No. 2003/0139905 (hereinafter the Helsper reference), and further in view of McGee et al., International Publication No. WO 03/009140 (hereinafter the McGee reference).

Claim 44 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Helsper-McGee as applied to claim 42 above, and further in view of Spoerre et al., U.S. Patent No. 5,602,761 (hereinafter the Spoerre reference).

Independent claim 19 and several claims dependent on other independent claims were not rejected under 35 U.S.C. § 103(a) but were only rejected under 35 U.S.C. § 101. The claims not rejected under 103(a), whether through combination of the Helsper reference and the McGee reference or with the addition of the Spoerre reference, each contained two limitations describing a learning responsiveness ratio and the use of the ratio in signature creation (below):

wherein creating a signature comprises accelerated learning through setting a learning responsiveness ratio and incrementally increasing the learning responsiveness ratio until the learning responsiveness ratio reaches a desired value, and

wherein the learning responsiveness ratio is equated to the second weighting factor divided by the first weighting factor

None of the cited references were cited for describing the above limitations. As such, the above limitations (or slightly modified variants) were incorporated into independent claims 1, 10, 28, 34, and 42. Claims 2 and 4-8 depend directly or indirectly from independent claim 1, claims 11 and 13-17 depend directly or indirectly from independent claim 10, claims 29-33 depend either directly or indirectly from independent claim 28, claims 35 and 37-41 depend directly or indirectly from independent claim 34, and claims 43-44 depend directly from independent claim 42. These dependent claims are believed to be in condition for allowance by virtue of their dependency. *See* 37 C.F.R. § 1.75(c). As such, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claims 1-2, 4-8, 10-11, 13-17, 28-33, 34-35, 37-41, and 42-44 is respectfully requested.

CONCLUSION

For at least the reasons stated above, claims 1-2, 4-8, 10-11, 13-17, 19-26, 28-35, and 37-44 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or cduncan@shb.com (such communication via email is herein expressly granted) – to resolve the same.

The fee for a two-month extension of time is submitted herewith. It is believed that no additional fee is due, however, the Commissioner is hereby authorized to charge any amount required, or credit any overpayment, to Deposit Account No. 19-2112.

Respectfully submitted,

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